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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,680	10/05/2001	Eun-Sook Sung	Q65732	1847

7590 02/09/2007

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/970,680	SUNG ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 have been examined.

Response to Amendment

2. The Amendment filed on 1/10/2007 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 9, 10, 12, 13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (5,848,396).

Claims 1, 10, 12, 13. A method of advertising on the Internet comprising:

(a) grouping advertisements which can be displayed in at least one predetermined area of a web page;

(b) determining a sequence for the advertisements included in the groups according to predetermined criteria;

(c) assigning channel numbers to the advertisements on the basis of the determined sequence; and

(d) establishing a database to connect the predetermined areas to the groups of advertisements and the channel numbers (Fig. 2; Fig. 5c; Fig. 5d; col 12, lines 20-55; col 14, lines 45-50; col 7, lines 5-23; col 15, lines 10-15).

Claim 3, 15: Gerace further discloses that the advertisements are grouped according to advertisers or service categories (col 3, lines 4-10).

Claim 9: Gerace further discloses that the predetermined areas are banner advertisement areas, bit map areas, or gif areas (col 8, lines 11-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Mason (2002/0161648).

Claims 2, 14: Gerace discloses the above. Gerace further discloses that content can be advertisement or other types of content (col 2, lines 60-67). Gerace further discloses that there are different ad and content areas (as disclosed above). Gerace further discloses different categories and areas for presentation of content/information (col 7, lines 24-56; col 8, lines 13-32).

Gerace does not explicitly disclose that the website has multiple ad areas each for different groups of advertising.

However, Mason discloses multiple ad areas/slots each for different groups/catergories/sets of advertising (Paragraph [11]; Figure 1; Figure 1, 'Insertion Order').

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Mason's ads categorized by ad slot/space to Gerace's categorized ads and multiple ad slots/spaces/areas per page. One would have been motivated to do this in order to better differentiate between different ad spaces on a page.

5. Claims 4-8, 11, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of do Rosario Botelho(20020069105).

Claims 4, 5, 6, 16: Gerace discloses the above. Gerace further discloses:

(e) displaying an advertisement in the predetermined area on a web page;

(f) shifting to a channel number of a next advertisement in the sequence;

(g) searching for an advertisement corresponding to the shifted channel number; and

(h) displaying the advertisement searched in the predetermined area (see rejection above).

Gerace does not explicitly disclose that the next advertisement in the sequence can be requested by a user. However, Gerace discloses the user requesting different content (col 5, lines 27-33; col 11, lines 35-41). Gerace further discloses that advertising is a form of content (col 2, lines 60-67). And, do Rosario discloses the next advertisement in the sequence can be requested by a user (Figure 4; Paragraphs [11, 42, 43]; Claim 16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add do Rosario's user requesting more ads to Gerace's presentation of ads in a sequence and the user requesting content/information. One would have been motivated to do this in order to allow the user to view more ads of interest.

Claims 7, 11: Gerace further discloses linking to a website if a link to the website of the advertisement displayed in the predetermined area is requested by the user (col 14, lines 25-35).

Claim 8: Gerace discloses the above. Gerace further discloses that it is determined that the link to the website of the advertisement is requested by the user if the user clicks a number of times on an icon in the predetermined area or on the advertisement displayed in the predetermined area (col 14, lines 25-35). Gerace does not explicitly disclose that double click can be the command. However, it is obvious that double click can be utilized for different input commands. One would be motivated to do this to take advantage of different available command options.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

On page 8 of the Applicant's Remarks dated 1/10/2007, Applicant states:

"Because Gerace discloses billing a Sponsor for the desired ads that are to be displayed for a given user, Gerace is not concerned with determining a sequence for the advertisement being displayed or if the sequence of the advertisement being displayed is based on predetermined criteria."

However, Examiners notes that teaching of a preference does not constitute a teaching away from the proposed combination under review. See In re Fulton, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

And, Examiner notes that while Gerace does disclose discloses billing a Sponsor for the desired ads that are to be displayed for a given user, that those features in no way preclude Gerace from also disclosing determining a sequence for the advertisement being displayed.

And, Gerace does disclose determining a sequence for the advertisement being displayed (Fig. 5d and below citations):

> "For a given advertisement, Ad Object 33d indicates to which series the advertisement belongs. To effectuate this, the Ad Object 33d indicates a series ID which references an Ad Series Object 33c, and indicates a series sequence (i.e., the ordering of the ads in a series). Ad Object 33d also includes the starting and ending time for display of the ad each day" (col 12, lines 40-55).

Hence, Gerace does disclose determining a sequence for the advertisement being displayed.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, the claims state minimal features of the predetermined criteria. Hence, the predetermined criteria are open to interpretation. And, Gerace discloses predetermined criteria where the criteria are the sequence that the ad was indicated to run in. Also, the time period for the ad, the max number of shows per day are also relevant criteria because, in addition to the sequence indicator, the time period and max shows will affect which ad is seen next in a series.

Hence, Gerace discloses the features of the Applicant's claims.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Brown (6,601,041):

"1. A method of operating a computerized system that targets advertisements to users of a communications network, comprising: defining advertising campaigns and defining advertisements to be displayed to users of the communications network in accordance with the advertising campaigns and targeting criteria associated therewith; defining an advertising sequence which requires that a series of said advertisements be displayed to a user in a sequential order; receiving requests for advertisements from applications running on the communications network; in response to a request for an advertisement, selecting an advertisement from said advertisements in accordance with an advertisement selection process and providing an identification of the selected advertisement to the requesting application, wherein the advertising selection process selects the advertisement based on a prioritized collection of said advertisements; determining whether the selected advertisement is part of said advertising sequence; if the selected advertisement is part of said advertising sequence, modifying the advertisement selection process such that a next advertisement in the advertising sequence is selected in response to a next request for an advertisement in connection with a same user to which the previously selected advertisement in the advertising sequence was provided.";

b) Haitsuka (6,928,615):

"22. The method of displaying advertisements to a user of an online service using a client application on a local device of claim 20, wherein the user-selectable icon includes a cycle-back icon, the cycle-back icon being associated with a cycle-back function, in the step of the client application detecting the user's selection of a given icon, the client application detecting the user's selection of the cycle-back icon, in the step of the client application providing the functionality associated with the given icon, the client application determining a next prior advertisement which the ad display process caused to be displayed, and the ad display process displaying the next prior advertisement.

23. The method of displaying advertisements to a user of an online service

using a client application on a local device of claim 20 wherein the user-selectable icon includes a cycle-forward icon, the cycle-forward icon being associated with a cycle-forward function, in the step of the client application detecting the user's selection of a given icon, the client application detecting the user's selection of the cycle-forward icon, in the step of the client application providing the functionality associated with the given icon, the client application determining a next advertisement which the ad display process caused to be displayed, if any, and the ad display process displaying the next advertisement.";

c) Galomb (2001/0039510): see claims;

d) Goldhaber (5,794,210);

e) McElfresh (2003/0149937).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
1/29/2007